UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/843,437	07/26/2010	Chun Yuen To	WWSM 2606.4 (WW/CA0723)	6189

321 7590 11/28/2016

SENNIGER POWERS LLP
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS, MO 63102

EXAMINER	
KATCOFF, MATTHEW GORDON	

ART UNIT	PAPER NUMBER
3725	

NOTIFICATION DATE	DELIVERY MODE
11/28/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHUN YUEN TO, HO PING CHENG, and JIN BIAO PI

Appeal 2015-002517
Application 12/843,437
Technology Center 3700

Before JENNIFER D. BAHR, JAMES P. CALVE, and AMANDA F. WIEKER, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the final rejection of claims 1–15. Appeal Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

CLAIMED SUBJECT MATTER

Claims 1, 8, and 11 are independent. Claim 1 is reproduced below.

1. A ring binder mechanism for holding loose-leaf pages, the mechanism comprising:

an elongate housing having a central portion and lateral sides extending downwardly along either side of the central portion;

a ring support comprising a pair of hinge plates in generally side-by-side relation and hingedly connected to one another for pivoting movement relative to each other, the hinge plates being held between the lateral sides of the housing;

a plurality of rings for holding the loose-leaf pages, each ring including a first ring member and a second ring member, the first ring member being mounted on the ring support for movement with the ring support relative to the housing between a closed position and an open position, in the closed position the first and second ring members forming a substantially continuous, closed loop for allowing loose-leaf pages retained by the rings to be moved along the rings from one ring member to the other, and in the open position the first and second ring members forming a discontinuous, open loop for adding or removing loose-leaf pages from the rings; and

an actuator mounted for pivotal movement relative to the housing about a pivot axis, the actuator comprising a pair of arms engageable with the hinge plates, the arms including a lower arm having a first contact surface engageable with the hinge plates during pivoting movement of the actuator in a first direction to move the rings from the closed position to the open position and an upper arm having a second contact surface engageable with the hinge plates during pivoting movement of the actuator in a second direction opposite said first direction to move the rings from the open position to the closed position, the first contact surface being spaced farther from the pivot axis than the second contact surface.

REJECTIONS

Claims 11–15 are rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over, Cheng (US 2005/0013654 A1, pub. Jan. 20, 2005). Final Act. 7.

Claims 1–10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cheng. Final Act. 9.

Claims 1–11 are rejected for non-statutory obviousness-type double patenting over U.S. Patent Nos. 7,819,602, 7,726,897, 7,819,602, and U.S. Patent Application No. 12/236,296. Final Act. 6.

ANALYSIS

Claims 11–15 as anticipated by, or unpatentable over, Cheng

The Examiner found that Cheng discloses a ring binder, as recited in independent claim 11, including an actuator (lever 615) with a pair of arms 549, 551 engageable with hinge plates to move rings 649 from the closed to the open position upon pivoting actuator 615 through an angle of about 16 to about 24 degrees. Final Act. 7–8. Alternatively, the Examiner determined that Cheng discloses the general angular movement of the actuator so the claimed range involves only the discovery of an optimum or workable range using routine skill in the art. *Id.* at 8. The Examiner also found that Cheng's actuator is capable of completing movement of the rings to the open position upon the movement of the actuator for 16 to about 24 degrees. *Id.* at 2.

Appellants argue that Cheng is silent about the angular movement of the lever needed to complete movement of the rings from the closed position to the open position. Appeal Br. 17. Appellants argue that Figures 16–17B do not show the rings in an open position or describe the amount of rotation of the actuator, and other figures show rotation of about 45°. *Id.* at 17–18.

The Examiner has not established by a preponderance of evidence that Cheng teaches or suggests a ring binder with an actuator configured to move the rings completely to an open position by pivoting through an angle in the range of about 16 degrees to about 24 degrees. The Examiner has not cited any express disclosure in Cheng of actuator rotation angles needed to move rings from a closed to an open position. Final Act. 8; Appeal Br. 17. The Examiner's finding that Cheng's actuator is capable of meeting the claimed rotation range (Final Act. 2) is unsupported by any record evidence. The Examiner must have a reasonable basis for finding that a prior art device is capable of meeting a functional limitation, e.g., by showing that the prior art has structure similar to that claimed. The Examiner has not established that Cheng has sufficient structure to make the actuator capable of opening the rings completely upon moving through the claimed range in order to shift the burden to Appellants to show that Cheng is not capable of doing so.

The Examiner's findings appear to be directed to the embodiment of Figures 16–17A of Cheng, which discloses an actuator as element 615. *See* Cheng ¶¶ 64–65, Figs 16, 17A; Final Act. 8. This embodiment does not show rings 649 being opened by the rotation of actuator lever 639.

Figures 11A and 21 show a lever rotated to about 45° with rings 249 shown open, but these *perspective* views relate to other embodiments, and the written description of these embodiments does not describe any of the angles of rotation that are used to open the rings completely. Even if the *perspective* drawings were clearer, they cannot be relied on to show precise angular displacements of the actuator, because they are not described in the specification as being drawn to scale, and the written description does not describe the degree of actuator rotation that is required to open the rings.

Although Cheng teaches generally that rotation of an actuating lever 39, 439, 639 causes rings to open on the binder, it is not clear what would be an optimum or workable range of actuator angles in this context or in the context of binders generally. Configuring a binder to open rings completely upon the rotation of an actuator through a smaller angle of about 16 to about 24 degrees, as claimed, may require more force to be exerted, which may be unsuitable for some applications. In the context of Cheng, a smaller rotation range may not permit locking bars to disengage sufficiently to allow the rings to open. *See* Cheng ¶¶ 61–62. We are not persuaded that it would have been obvious to arrive at the claimed range based on the disclosure of Cheng. Thus, we do not sustain the rejection of claims 11–15.

Claims 1–10 as unpatentable over Cheng

Claims 1–7

The Examiner found that Cheng discloses a ring binder, as recited in claim 1, with a pivotal actuator (lever 615) and a pair of arms 549, 551 that include contact surfaces that engage hinge plates to open and close rings 649 wherein the first contact surface of lower arm 551 is spaced farther from the pivot axis of actuator 615 than the second contact surface of upper arm 549, as shown in Figure 14. Final Act. 9–11. The Examiner reasoned that the very tip of lower arm 551 and the front underside of upper arm 549 must be the contact surfaces, and Figure 14 of Cheng teaches this feature because the tip of lower arm 551 is spaced farther from the pivot axis than the front underside of upper arm 549. *Id.* at 3. The Examiner also found that Cheng's drawings are not drawn to scale, and Cheng does not disclose the size of the upper and lower arms, but the Examiner found that Figure 14 can be relied on for what it discloses, and Figure 14 shows this spacing. Ans. 9–10.

The Examiner's findings are not supported by a preponderance of evidence. The Examiner's finding that Cheng implicitly discloses that parts of upper and lower arms 549, 551 are contact surfaces does not explain why the distal most portions are the contact surfaces. Appeal Br. 8–10. Even if Cheng disclosed contact surfaces as the Examiner found, Figure 14 does not show the tip of lower arm 551 spaced any further from the pivot than the tip of upper arm 549. Figure 14 is a perspective view with the tip of upper arm 549 and distance to hinge plate 417 obscured by wire line 541. Reply Br. 4. Thus, it is not clear that the tip of lower arm 551 is spaced further from the pivot than the tip of upper arm 549 in Figure 14. Figure 16 is an exploded perspective view showing arms 549, 551 with similar spacing, but there is no disclosure of dimensions in the Specification. Further, as the Examiner admits, there is no indication that the figures are drawn to scale. *See* Ans. 9.

Thus, we do not sustain the rejection of claims 1–7.

Claims 8–10

The Examiner found that Cheng discloses a binder with the lower arm 551 of actuator 615 being spaced at least about 6 mm away from the pivot axis, as recited in independent claim 8. Final Act. 12–13. The Examiner reasoned that Cheng's binder is designed to accommodate 11" x 14" paper so that dimension would result in the claimed spacing of the contact surface. *Id.* at 4. The Examiner measured the distances of the contact surfaces of the upper and lower arms to be 14 mm and 12 mm. Ans. 10. Alternatively, the Examiner determined that even if Cheng does not teach the claimed spacing of 6 mm, a change in size from the spacing disclosed in Cheng is generally recognized as being within the level of ordinary skill and therefore obvious. Final Act. 13.

Appellants argue that Figure 14 of Cheng cannot be relied on to show precise dimensions where the drawings are not disclosed as being drawn to scale, and there is no disclosure in Cheng of any spacing. Appeal Br. 15. Appellants argue that the Examiner's measurements of Figure 14 cannot support the rejection of claim 8. Reply Br. 6. Appellants also argue that the obviousness of a change in size does not account for the fact that Appellant's device performs differently and the Examiner's determination amounts to an improper *per se* rule of unpatentability. Appeal Br. 15–16. We agree, for the reasons articulated by Appellants.

Thus, we do not sustain the rejection of claims 8–10.

Claims 1–11 for obviousness-type double patenting

Appellants acknowledge the double patenting rejections of claims 1–11 (Appeal Br. 3), but do not present arguments traversing those rejections (*id.* at 3–20). Instead, Appellants request that the prior art rejections be reversed and the application be remanded to resolve the double patenting rejections. *Id.* at 20. In the absence of arguments traversing the double patenting rejections, we summarily sustain the double patenting rejections of claims 1–11.

DECISION

We reverse the prior art rejections of claims 1–15.

We affirm the double patenting rejections of claims 1–11.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART